REMARKS

Claims 1-4 and 7-25 are currently pending in the subject application and are presently under consideration. Claims 1, 3-4, 12, 15, 17-20, 22 and 24-25 have been amended. Claims 2, 7-11, 16, 21 and 23 have been cancelled. Applicant's representative submits that, as argued in the Appeal Brief, the claims prior to amendment are allowable over the cited art. Moreover, as the Court of Appeals for the Federal Circuit has held, software alone is patentable subject matter. (*See Eolas Technologies, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1339, 73 U.S.P.Q.2d 1782 (Fed. Cir. 2005) and *AT&T Corp v. Microsoft Corp.*, 414 F.3d 1366, 1368, 75 USPQ2d 1506 (Fed. Cir. 2005)). However, in order to expedite prosecution, the claims have been amended. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   Rejection of Claims 19, 20 and 25 Under 35 U.S.C §112

Claims 19, 20 and 25 stand rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The subject claims have been amended and accordingly, withdrawal of the rejection is respectfully requested.

II.   Rejection of Claims 1 and 15 Under 35 U.S.C. §101

Claims 1 and 15 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The subject claims have been amended and accordingly, withdrawal of the rejection is respectfully requested.

III. Rejection of Claims 1-4, 7-13 and 15-25 Under 35 U.S.C. §102(e)

Claims 1-4, 7-13 and 15-25 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,457,170 (Boehm, *et al.*). Withdrawal of this rejection is respectfully requested for at least the following reasons. Neither the multi-workstation embodiment nor the single workstation embodiment taught by Boehm *et al.* discloses each and every limitation of the subject claims. In particular, the multi-workstation embodiment does not *store build files locally on the build machines*. The single workstation embodiment does not have a *plurality of build machines, at least two of which are executing on different computers*.

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A single prior art reference anticipates a patent claim if *"each* and *every* limitation set forth in the patent claim" is disclosed either expressly or inherently. (*Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597, 1599 (Fed. Cir. 2002) (citing to *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1052-53 (Fed. Cir. 1987))) (emphasis added). Moreover, "[t]he *identical* invention must be shown in as *complete* detail as is contained in the patent claim." (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (citing *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 U.S.P.Q. 253, 257 (Fed. Cir. 1985); and *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983))) (emphasis added).

Boehm *et al.* discloses a system for building software in a networked software development environment. The multi-workstation embodiment of the system of Boehm *et al.* stores build files in a network cache memory that is not resident on a user's local workstation. (*See e.g.*, Boehm *et al.* at col. 6, lines 2-14). As defined in Boehm *et al.*, a network cache memory is an "electronic memory 32 *located on the network* that is quickly accessible by each local workstation." (*See* Boehm *et al.* at col. 5, lines 39-41; *see also* Figure 1, element 32) (emphasis added). To build a software program, the user must first create a build list by entering the name of each source and object file constituent of the software to be built. (*See* Boehm *et al.* at col. 2, lines 43-47; col. 4, lines 6-10; and col. 18, line 36). From this build list, the system creates a cache link structure (*i.e.*, a directory tree of file links). The system provides the cache link structure to a software building program, such as MAKE, running on the user's local workstation. The software building program accesses the files stored in the network cache memory by using the links to the cached copies of the files provided in the cache link structure. (*See e.g.*, Boehm *et al.* at col. 2, lines 46-64 and col. 14, lines 51-55). Thus, the software building program works with "local links, *rather than local copies of entire files,* allow[ing] multiple users to share frequently-accessed building-block type files, and eliminate[ing] the need to download and then manipulate duplicate files." (Boehm *et al.* at col. 6, lines 7-10) (emphasis added). Boehm *et al.* also discloses a single workstation embodiment that runs on a standalone workstation and that utilizes a local cache to store files. (*See e.g.*, Boehm *et al.* at col. 9, lines 12-14).

Anticipation requires that the *identical* invention be disclosed in a single reference. (*See e.g.*, *Richardson*, 868 F.2d at 1236, 9 U.S.P.Q.2d at 1920). Neither of the systems disclosed in

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Boehm *et al.* have all of the limitations of the subject claims together *in one system*. All of the subject claims recite the limitation that the ***build files are stored locally on the build machines*** or a similar limitation. As discussed *supra*, the multi-workstation embodiment of Boehm *et al.* builds software from source and object files that are stored in a network cache memory that is not resident on a user's local workstation. (*See e.g.*, Boehm *et al.* at Fig. 1, element 32 and col. 5, lines 39-41). Thus, the multi-workstation embodiment does not store the build files locally on the build machines.

All of the subject claims recite the limitation that there are a ***plurality of build machines, at least two of which are executing on different computers*** or a similar limitation. The single workstation embodiment disclosed in Boehm *et al.* is practiced on a standalone workstation. This system has only *one* build machine, not a plurality of build machines at least two of which are executing on different computers as recited in the subject claims. Thus, the single workstation embodiment of Boehm *et al.* does not anticipate the subject claims. Accordingly, for at least the foregoing reasons, withdrawal of this rejection and allowance of the subject claims is respectfully requested.

IV.   Rejection of Claim 14 Under 35 U.S.C. §103(a)

Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent 6,457,170 to Boehm, *et al.* in view of Microsoft Press Computer Dictionary, Second Edition, hereinafter referred to as Microsoft. Claim 14 depends from claim 15, which is allowable for at least the reasons stated *supra*. Accordingly, withdrawal of this rejection and allowance of the subject claim is respectfully requested.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP159US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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